

DOCKET NO.: ISIS-3561

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Bennett et al.

Serial No.: 09/315,292

Group Art Unit: 1635

Filed: May 20, 1999

Examiner: L. Nguyen

For:

**COMPOSITIONS AND METHODS FOR THE PULMONARY DELIVERY  
OF NUCLEIC ACIDS**

I, **Emma R. Dailey**, Registration No. **48,491** certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

On December 18, 2001

*Emma R. Dailey*  
Emma R. Dailey, Reg. No. 48,491

Assistant Commissioner for Patents  
Washington, D.C. 20231

**REQUEST FOR CONTINUED PROSECUTION  
PURSUANT TO 37 C.F.R. § 1.114(c)**

This submission is filed in connection with Applicants' Request For Continued Prosecution, filed herewith, in connection with the above referenced patent application.

Applicants note that Examiner Nguyen is now in charge of this application.

Applicants thank the Examiner for indicating in a telephone conversation with Applicants' undersigned attorney Michael P. Straher that the Examiner would be amenable to having an

Office Interview to discuss the outstanding issues in this and related applications. Applicants' undersigned attorney will contact the Examiner in the near future to arrange an acceptable time for such an interview.

In anticipation of the interview, Applicants address herein certain issues outstanding from prior prosecution of the present application.

In the Advisory Action issued in connection with this application, Examiner Shibuya questioned certain references submitted by Applicants in support of their priority claim. Further to that submission, Applicants submit herewith the declaration of Gregory E. Hardee ("the Hardee declaration") which shows that one of ordinary skill in the art at the time the 07/801,168 priority application was filed, would have been able to formulate and deliver oligonucleotides, including antisense oligonucleotides, to the lungs. Accordingly, Applicants respectfully request acknowledgment of the claim for priority made in Applicants' Amendment and Request for Reconsideration mailed May 21, 2001, and further request reconsideration and withdrawal of the rejections of record in view of the effective filing date to which the present application is entitled. Applicants look forward to discussion these issues with the Examiner at the Interview.

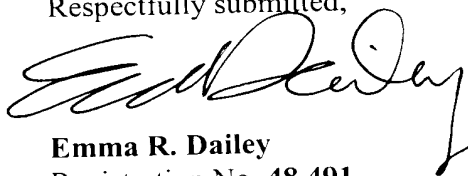
The Advisory Action also suggests that the proposed amendments after the final rejection (*i.e.*, removal of the limitation "wherein said antisense oligonucleotide is not directed to an A<sub>1</sub> or A<sub>3</sub> adenosine receptor and is not contained in an expression vector") would change the scope of the claims and would require further consideration and search. Applicants note, however, that the limitation was added by amendment on October 24, 2000, in response to the

first Office Action, and was not recited in the claims as originally searched. Accordingly, removal of the limitation would result in claims of identical scope to those initially searched by the Examiner. Applicants therefore respectfully renew their request for entry of the amendments.

The Advisory Action further suggests that the copy of the specification of serial no. 08/383,666 provided with Applicants' previously filed response "is not the same as serial no. 08/383,666 and lacks amendments and the prosecution record." Applicants respectfully submit, however, that the specification is the "as-filed" version of application serial no. 08/383,666, and that for purposes of acknowledging a claim of priority, the prosecution record and amendments made subsequent to filing of the 08/383,666 specification are not relevant.

Applicants respectfully submit that the claims presently before the Examiner patentably define the invention over the applied art and are otherwise in condition for ready allowance.

Respectfully submitted,



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Date: **December 18, 2001**

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